

Amendment in Response to Final Rejection under 37 CFR 1.114
Title: "Container with Improved Stacking/Denesting Capability"
Filed: January 18, 2001

Atty Docket No. R029 1337

REMARKS

Claims 1-12, 16-17, 19 and 21-34 are presented for examination. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and allowance of the application.

Claim Rejections Under 35 USC § 112

Claims 17, 20 and 21 stand rejected under 35 USC § 112, second paragraph as being indefinite. Applicant respectfully traverses.

The clause associated with the instance of "said" cited by the Examiner has been deleted from claim 17, rendering this rejection moot. This amendment has been made for purposes of clarification and not for the purpose of narrowing the scope of the claim.

Applicant has also inserted paragraph breaks into the claims to improve their readability, and not for the purpose of distinguishing over any prior art reference.

Claim Rejections Under 35 USC § 102

Claims 1-6, 9-11 and 17 stand rejected under 35 USC § 102(b) as being anticipated by *Keiding* (U.S. Pat. No. 1,986,824). Applicant respectfully traverses.

Claim 1 recites a nestable paperboard container. Claim 1 defines over *Keiding* in that *Keiding's* receptacle is formed from molded pulp, and is not a "paperboard container."

Further, *Keiding's* receptacle is not "press-formed from a single substantially flat blank, the blank being substantially comprised of a paperboard material." It has been held that certain process limitations may convey structural limitations. See *In re Garnero*, 56 C.C.P.A. 1289, 412 F.2d 276, 162 U.S.P.Q. 221 (CCPA 1969). In *Garnero*, the CCPA stated (emphasis added):

However, it seem to us that the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations. *Id.* at 1292, 279.

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Press-forming conveys distinct structural properties to a resulting container, as do the methods of press fitting, welding, etc. cited by the CCPA. Applicant therefore submits that the recitation of a press-formed container should be given patentable weight so that the examination process conforms with Federal Circuit precedent.

Further, *Keiding* does not disclose a "sidewall comprising a plurality of pleats extending up the sidewall created by folds in the blank," as recited in amended claim 1.

Amended claim 17 also recites a container that is press-formed from a blank "substantially comprised of a paperboard material," and a "plurality of pleats extending up the sidewall created by folds in the blank." Claim 17 therefore defines over *Keiding*.

Claims 1-4, 9, 10 and 17-21 stand rejected under 35 USC § 102(b) as being clearly anticipated by *Morita et al.* (U.S. Pat. No. 5,721,022). Applicant respectfully traverses.

Morita is directed to a disposable pan 10 made from paper sheet material. The pan 10 is not "press-formed from a single substantially flat blank, the blank being substantially comprised of a paperboard material," as recited in claim 1. *Morita* therefore fails to anticipate claim 1.

Morita also fails to disclose a sidewall having "a bulge projecting inwardly from" the inner surface of a sidewall. Referring to Figures 1, 2, 6, 7 and 10 of *Morita*, the pan sidewalls are substantially smooth and terminate at an outward flange 14.

Similarly, *Morita*'s pans lack bulges "projecting outwardly from the outer surface" of a sidewall, with the "thickness of the sidewall being greater at at least some locations along said bulges than at other locations on said sidewall." To the contrary, *Morita*'s sidewalls appear to be simple frustoconical sections.

Claim 17 also recites a container that is press-formed from a blank substantially comprised of paperboard, and having inwardly and outwardly projecting bulges. Claim 17 therefore defines over *Morita*.

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Claims 1-4, 9, 10 and 17-21 stand rejected under 35 USC § 102(b) as being clearly anticipated by *Hirano* (U.S. Pat. No. 6,270,003). Applicant respectfully traverses.

Hirano is directed to a cake container 1 formed from a folded paper sheet. The container 1 is therefore not "press-formed from a single substantially flat blank, the blank being substantially comprised of a paperboard material." Claims 1 and 17 therefore define over *Hirano*.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC § 102.

Claim Rejections Under 35 USC § 103

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.¹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.²

An essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references.³ Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.⁴

¹ See MPEP §2143.

² *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

³ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998).

⁴ *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985).

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Claims 1-10, 12, 16 and 17 stand rejected under 35 USC § 103(a) as being unpatentable over *Newman et al.* (U.S. Pat. No. 4,832,202) in view of *Keiding*. Applicant respectfully traverses.

Newman is directed to a thermoplastic drinking cup having a plurality of ribs 10 (Figure 2) extending around the cup periphery. *Newman*'s cup is not made from paperboard, and includes no pleats. In the rejection, the Examiner admits that *Newman* fails to disclose paperboard material, and states: "*Keiding* teaches paperboard material. It would have been obvious to replace the plastic material with paperboard material in order to reduce material costs." This statement of obviousness is insufficient because it is based on factual error; *Keiding* does not disclose paperboard, and instead discloses a receptacle formed from molded pulp. Therefore, *Newman* and *Keiding*, when taken together, fail to disclose every element recited in amended claims 1 and 17, and the rejection should be withdrawn.⁵

It is also improper to assert that one of ordinary skill in the art would have been motivated to replace the plastic material of *Newman* with the molded pulp of *Keiding*. The processes of plastic molding and pulp molding are non-analogous fields of art, require different facilities to perform, and result in products with completely different properties. It is therefore unreasonable to assert that one would look to the field of art of *Keiding* to solve any problems or deficiencies that might arise when forming the drinking cup of *Newman*.⁶ Without some suggestion in the prior art to combine the disparate teachings of *Keiding* and *Newman*, the rejection cannot stand.⁷

Claims 1-8, 12, 16 and 17 stand rejected under 35 USC § 103(a) as being unpatentable over *Petitto* (U.S. Pat. No. 3,836,042) in view of *Keiding*. Applicant respectfully traverses.

⁵ See MPEP §2143.

⁶ See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543.

⁷ See *Ex parte Skinner*, 2 U.S.P.Q.2d 1789, 1790 (PO Bd. App. 1986) ("When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper....Absent such reasons or incentives, the teachings of the references are not combinable.").

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Petitto is directed to plastic containers having nesting lugs. *Petitto*'s containers are not made from paperboard, and do not include pleats. *Keiding* also fails to disclose a paperboard container having pleats, as discussed in detail above. *Petitto* and *Keiding* therefore cannot, when taken together, disclose the combination of elements recited in claims 1 or 17.⁸

In the rejection, the Examiner admits that *Petitto* fails to disclose paperboard, and states that it would have been "obvious to replace the plastic material with paperboard material in order to reduce material costs." This statement is improper because *Keiding* fails to disclose paperboard, and because one of ordinary skill in the art would not be motivated to use paperboard molding techniques in addressing problems in a plastic molding process.⁹

Therefore, *Petitto* and *Keiding*, when taken together, fail to disclose the combination of elements recited in amended claims 1 and 17, and the rejection should be withdrawn.

Claims 1-12 and 17 stand rejected under 35 USC § 103(a) as being unpatentable over *Keiding* in view of *Sorenson* (U.S. Pat. No. 5,176,284). Applicant respectfully traverses.

Sorenson is directed to a plastic container 10 having a perimetric ledge 18, an upper perimetric wall section 20, and a tapered lower perimetric wall section 24. *Sorenson*'s container 10 is not made from paperboard and includes no pleats.

The combination of paper pulp mold processes with plastic forming processes is improper for at least the reasons discussed above. Further, because neither *Sorenson* nor *Keiding*, alone or in combination, disclose paperboard or press-forming processes, they fail to disclose every element recited in claims 1 and 17. The rejection should therefore be withdrawn.¹⁰

Claims 1-6, 9-11 and 17-21 stand rejected under 35 USC § 103(a) as being unpatentable over *Keiding* in view of *Morita, Hirano, Lavigne* (U.S. Pat. No. 2,831,623) and *Stocking* (U.S. Pat. No. 2,837,778). Applicant respectfully traverses.

⁸ See MPEP §2143.

⁹ See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543.

¹⁰ See MPEP §2143.

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As discussed above, *Keiding*, *Morita*, and *Hirano* all fail to disclose paperboard containers as recited in independent claims 1 and 17.

Lavigne is directed to a non-nestable milk container made from a fibrous sheet of material. *Lavigne*'s container is not made from press-formed paperboard, and fails to cure the deficiencies of the cited patents in disclosing the claimed invention. In the rejection, the Examiner states that it would have been obvious to "modify the construction of *Keiding* to be formed with pleats and corresponding score lines in order to control the amount of material being used..." Applicant traverses this statement on the grounds that it would not be possible to "modify" the construction of *Keiding* by using a blank as taught by *Lavigne*. *Keiding*'s receptacle is formed in a pulp molding apparatus, and the use of a blank as taught by *Lavigne* to produce the receptacle would not result in a receptacle having "smooth walls free of mold marks" and "uniform thickness throughout [except for the ribs 2]," which is the "primary object" of *Keiding*'s invention.¹¹ To the contrary, the use of a paperboard blank, and the resulting pleats, would necessarily contravene the primary object of *Keiding*'s invention.

Stocking is addressed to containers formed from plastic or fibrous sheets impregnated with plastics, and therefore fails to cure the deficiencies of *Keiding*, *Morita* and *Hirano* in disclosing the combination of limitations recited in claims 1 and 17.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC § 103(a).

New Claims

New claims 22-34 are presented herewith for examination. Independent claim 26 recites pleated sidewalls and ring-like bulges formed from a plurality of ribs, features which are not shown in the cited patents.

¹¹ See column 1, lines 3-14 of *Keiding*.

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CONCLUSION

In view of the above remarks, Applicant respectfully asserts that the rejections of the claims as set forth in the Final Office Action have been addressed and overcome. Applicant further respectfully asserts that all claims are in condition for allowance and requests that an early notice of allowance be issued.

If issues may be resolved through Examiner's Amendment, or clarified in any manner, please call the undersigned attorney at (404) 879-2443.

The Commissioner is hereby authorized to charge any required fees or credit any overpayment to Deposit Account No. 09-0528.

Respectfully submitted,

James A. Thompson Reg. No. 36,723
For C. Keith Montgomery
Registration No.: 45,254

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Customer No. 26158
Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
(404) 879-2443 (Telephone)
(404) 879-2943 (Facsimile)